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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/616,101	07/08/2003	Ying Luo	RIGL-010CIP3	5361
24353 7590 03/16/2007 BOZICEVIC, FIELD & FRANCIS LLP 1900 UNIVERSITY AVENUE SUITE 200 EAST PALO ALTO, CA 94303			EXAMINER RAO, MANJUNATH N	
			ART UNIT 1652	PAPER NUMBER
			MAIL DATE 03/16/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Advisory Action</b> <b>Before the Filing of an Appeal Brief</b>	Application No.	Applicant(s)	
	10/616,101	LUO ET AL.	
	Examiner	Art Unit	
	Manjunath N. Rao, Ph.D.	1652	

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 26 February 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

#### AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☒ Applicant's reply has overcome the following rejection(s): See attached.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_.  
Claim(s) objected to: \_\_\_\_\_.  
Claim(s) rejected: 38-44.  
Claim(s) withdrawn from consideration: 45-47.

#### AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☒ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

#### REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See attached.  
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_  
13. ☐ Other: \_\_\_\_\_.

Manjunath N. Rao, Ph.D.  
Primary Examiner  
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***Advisory Action***

Claims 38-47 are now currently pending in this application. Claims 38-44 are now under consideration. Claims 45-47 remain withdrawn from consideration as being drawn to non-elected invention.

Applicant's amendment, arguments and the Declaration filed under Rule 1.131, filed on 2-26-07 has been considered and ENTERED. However, claims are still not in condition for allowance for the following reasons.

Examiner would first of all like to point out that the amendment to claims filed on 2-26-07 is non-compliant for the following reason. Claim 44 is indicated as "currently amended". Applicant fails to show any mark-up of the amendment that has been carried out to the claim. However, in order to expedite the prosecution of this case, Examiner has compared the claim language with the previous version of claim 44 and has concluded that applicant has made a typographical error and examined the claim.

***Withdrawal of the finality of the previous Office action***

In the response filed on 2-26-07, applicant has made an issue of the finality of the previous Office action. Examiner respectfully disagrees that the finality of the previous Office action was in any way improper. Claims filed on 8-28-06 were basically drawn to any composition comprising any recombinant tankyrase H protein and were not limited to any specific SEQ ID NO. Because the original claims were NOT limited to any specific SEQ ID NO, the Examiner's search of the non-sequence database itself yielded the best available prior art. Because applicant did not include specific SEQ ID NO in the claims it did not require the

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Examiner to initiate the search for a SEQ ID on sequence databases. As stated above, Examiner used the best available prior art for those claims, under 35 USC 102(b), which placed a statutory bar, in order to reject those claims. In response to that rejection, applicants amended the claims to recite specific SEQ ID NO which also overcame the rejection under 35 USC 102(b). The inclusion of the specific SEQ ID NO in the amended claims triggered the search of the sequence databases which yielded the new references that Examiner used to reject those claims.

Examiner vehemently disagrees with the applicant's highly misplaced argument that the new grounds of rejection were not triggered by the amended claims. The recitation of the SEQ ID NO triggered a new search of the sequence databases. Applicants could have presented the SEQ ID NO in the claims before Examiner issued the first non-final rejection. In view of the above Examiner continues to maintain the finality of the Office action mailed on 1-5-07.

Examiner continues to maintain the rejection of claims 38-40 and 42 as being anticipated by Daly et al. In response to the above rejection in the previous Office action, applicant has made a persuasive argument against all the cited references except for Daly et al. With respect to Daly et al. reference, applicant argues that Daly fails to disclose a composition containing a source of ADP-ribose and, as such, fails to disclose the subject matter of the rejected claims and that Daly cannot anticipate the rejected claims. Examiner respectfully disagrees. Daly et al. reference has a effective prior date of September 1998. Applicant has filed a Declaration swearing behind the date of June 1999. Contrary to the above argument, Daly et al. reference discloses a polypeptide that is more than 97% identical to SEQ ID NO:3. Daly et al. further teach a composition comprising the same in a cell or a cell extract, in a mammalian cell or as a

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mammalian cell extract. The reference also teaches a fusion protein comprising the polypeptide and a composition comprising the polypeptide in a cell extract and a candidate bioactive agent such as an antibody (see the entire column 2 on page 1 and columns 1 and 2 on page 2) thus anticipates the entire set of claims. While Daly et al. do not disclose that their polypeptide has the functional activity of tankyrase H protein, in view of the high sequence homology, Examiner takes the position that said functional property would be inherent in the polypeptide of Daly et al. which would be recognized by those skilled in the art. Examiner also takes the position that the cells or cell extracts of Daly et al. inherently comprise a source of ADP ribose as well.

Therefore, Examiner continues to maintain the rejection.

For the very same above reasons, Examiner continues to maintain the rejection of claims 41, 43-44 as being obvious under 35 USC 103(a), over Daly et al., and Smith et al.

### *Conclusion*

None of the claims are allowable.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Manjunath N. Rao, Ph.D. whose telephone number is 571-272-0939. The Examiner can normally be reached on 7.00 a.m. to 3.30 p.m. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, Ponnathapura Achutamurthy can be reached on 571-272-0928. The fax phone numbers for the organization where this application or proceeding is assigned is 571-273-8300 for regular communications and for After Final communications. Any inquiry of a general nature or relating to the status of

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this application or proceeding should be directed to the receptionist whose telephone number is  
571-272-1600.

A handwritten signature in black ink, appearing to read 'Manjunath'.

Manjunath N. Rao, Ph.D.  
Primary Examiner  
Art Unit 1652

March 13, 2007